UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,359	09/27/2001	Paul Kenneth Whittingham	13347US01	6427

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EXAMINER
ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/965,359	WHITTINGHAM ET AL.
	Examiner	Art Unit
	Neveen Abel-Jalil	2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _26 September 2005_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _14-50, 52-53, 55-56_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _14-24, 29-31, 33-42, 47-50, 52, 53, 55 and 56_ is/are rejected.

7) ☒ Claim(s) _25-28, 32 and 43-46_ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _12/27/04_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Remarks

1.   The Amendment filed on September 26, 2005 has been received and entered. Claims 51, 54, and 57-58 have been cancelled. Therefore, claims 14-50, 52-53, 55-56 are now pending.

2.   After further search and consideration, new art has been found therefore a new non-final office action is presented herewith in.

Claim Objections

3.   Claims 35-36, 39-41, 49, and 55-56 are objected to because of the following informalities:

The dependency of claim 55 is inaccurate. Claim 55 can't be dependent on claim 54 since it a cancelled claim. The dependency of claim 56 is inaccurate. Claim 56 can't be dependent on claim 54 since it a cancelled claim. Appropriate correction is required.

In claims 35-36, 39-41, and 49, the recitation of "can be" is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 47-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

        Claim 47 recites the limitation "the plate" in line 3. There is insufficient antecedent basis

for this limitation in the claim.

        Claim 48 recites the limitation "the minimal number" in line 2. There is insufficient

antecedent basis for this limitation in the claim.

        Claim 48 recites the limitation "the number of plates" in line 4. There is insufficient

antecedent basis for this limitation in the claim.

        Claim 48 recites the limitation "the estimated production" in line 4. There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 14-21, 24, 29-31, 33-42, 47, 49-50, 52-53, and 56 are rejected under 35

U.S.C. 102(e) as being anticipated by <u>VanDenAvond et al.</u> (U.S. Pub. No. 2003/0004946 A1).

        As to claim 14, <u>VanDenAvond et al.</u> discloses a method of producing labels at a remote

location in communication with a server and central database via the internet, comprising:

        receiving via the internet one or more orders for labels, the orders identifying variable

data to be printed on the labels (See page 2, paragraph 0029);

        storing the received orders in the central database (See abstract);

        receiving a request via the internet to process one or more orders for production (See

page 6, paragraphs 0064-0065);

        storing a plurality of printing templates for a plurality of customers (See page 5,

paragraphs 0051-0053);

        merging printing data identified in the one or more orders to be processed and a template

selected from the plurality of stored templates to generate image data for the labels to be printed

for the one or more processed orders (See page 6, paragraphs 0070-0071); and

        storing in the central database the generated image data for communication via the

internet to a remote location for label production wherein the image data for the processed orders

stored in the central database is associated with one of a plurality of different types of label

production machines (See page 2, paragraph 0025, wherein "production machines" reads on

"printer devices", also see page 4, paragraph 0043, and page 6, paragraph 0073);

        receiving a request via the internet to change the production machine for the labels (See

page 5, paragraphs 0054-0055); and

reprocessing the orders in accordance with a different printing template associated with

the changed production machine (See page 6, paragraph 0073).

As to claim 15, <u>VanDenAvond et al.</u> discloses a method of producing labels at a remote

location in communication with a server and central database via the internet, comprising:

receiving via the internet one or more orders for labels, the orders identifying variable

data to be printed on the labels (See page 6, paragraph 0071);

storing the received orders in the central database (See page 4, paragraphs 0046-0047,

also see page 5, paragraph 0050);

receiving a request via the internet to group a plurality of orders together as a printing job

(See page 2, paragraph 0027);

generating job data including information representing a type of label to be produced for

the job, the variable data to be printed on labels to be produced for the job, and a type of machine

to be used in the production of the labels for the job (See Figure 13, also see page 2, paragraph

0025, and see page 5, paragraph 0054);

storing a plurality of printing templates for a plurality of label types and a plurality of

machine types used in the production of the labels (See page 6, paragraph 0073);

selecting a stored template in accordance with the type of labels to be produced and the

type of machine to be used in the production of the labels (See page 2, paragraph 0025, also see

page 2, paragraph 0028);

merging the variable data to be printed on the labels and a selected printing templates to

generate image data for the labels in a production data file to be used in the production of the

labels (See page 5, paragraph 0061, also see page 6, paragraph 0070, and see page 6, paragraphs

0073-0074);

storing the production data file in the central database (See pages 2-3, paragraph 0030);

and

sending the stored production data file to a remote location via the internet (See page 3,

paragraph 0034).

As to claim 16, VanDenAvond et al. discloses wherein the information representing the

type of machine to be used in production of the labels is an identified production technique (See

page 2, paragraphs 0025-0026).

As to claim 17, VanDenAvond et al. discloses wherein the steps of selecting a template,

merging the data, and storing the production data file are automatically implemented in response

to receipt of a confirmation to process a job (See page 2, paragraph 0028, also see page 5,

paragraphs 0051-0052).

As to claim 18, VanDenAvond et al. discloses wherein the production data file generated

can be directly input to the type of production machine for which the production data file was

generated (See page 4, paragraph 0043, also see page 5, paragraph 0054).

As to claim 19, VanDenAvond et al. discloses wherein the one or more orders can be

received from one or more locations and the request to process the orders can be received from a

different location (See page 3, paragraph 0031).

As to claim 20, <u>VanDenAvond et al.</u> discloses wherein the one or more orders can be

received from a location and the request to process the orders can be received from the same

location (See page 6, paragraph 0071, wherein "same location" reads on "local copy").

As to claim 21, <u>VanDenAvond et al.</u> discloses wherein a plurality of orders can be

received from different locations and processed together as one print job (See page 4, paragraph

0043, also see page 4, paragraphs 0048).

As to claim 24, <u>VanDenAvond et al.</u> discloses wherein at least one of the stored

templates defines a layout of in formation to be printed on a label (See page 3, paragraph 0038,

also see page 5, paragraph 0054).

As to claim 29, <u>VanDenAvond et al.</u> discloses wherein the production file includes a data

stream that can be directly input to a printer for printing the labels of a job (See page 4,

paragraph 0043, also see page 5, paragraph 0054).

As to claim 30, <u>VanDenAvond et al.</u> discloses wherein the production file includes font

information (See page 4, paragraph 0054).

As to claim 31, <u>VanDenAvond et al.</u> discloses wherein the production file includes graphic information (See page 5, paragraphs 0058-0059).

As to claim 33, <u>VanDenAvond et al.</u> discloses a method of producing labels at a remote location in communication with a server and database via the internet, comprising:

storing a plurality of orders for labels in the database, the orders identifying variable data to be printed on the labels (See Figure 13, shows "variable" data);

generating job data for a plurality of orders to be processed together, the job data including information representing a type of label to be produced for the job, a type of machine to be used in the production of the labels for the job, and the variable data to be printed on labels to be produced for the job (See Figure 13, also see page 2, paragraph 0025, and see page 5, paragraph 0054);

storing a plurality of printing templates for a plurality of label types and a plurality of machine types used in the production of the labels (See page 5, paragraphs 0051-0053);

selecting a stored template in accordance with the type of labels to be produced (See page 2, paragraph 0028, also see page 5, paragraphs 0060-0061); and

merging the variable data to be printed on the labels and a selected printing template to generate image data for the labels in a production data file to be used in the production of the labels, the type of production data file generated corresponding to the type of machine to be used in the production of the labels (See page 6, paragraphs 0070-0071);

storing the production data file (See pages 2-3, paragraph 0030); and

sending the stored production data file to a remote location via the internet (See page 2, paragraph 0026, also see page 6, paragraphs 0064-0065).

As to claim 34, VanDenAvond et al. discloses including the step of receiving orders for labels from a remote location via the Internet and wherein the orders and production data files are stored in a central database (See page 3, paragraph 0031, and see page 3, paragraph 0034, wherein "Internet" reads on "web").

As to claim 35, VanDenAvond et al. discloses wherein the orders in a job can be received from different locations (See page 5, paragraph 0053).

As to claim 36, VanDenAvond et al. discloses wherein the production data file can be sent to a remote location that is the same or different from the remote locations from which the orders for a job are received (See page 6, paragraph 0071).

As to claim 37, VanDenAvond et al. discloses wherein the information representing the type of machine to be used in production of the labels is an identified production technique (See page 2, paragraphs 0025-0026).

As to claim 38, VanDenAvond et al. discloses wherein the steps of selecting a template, merging the data, and storing the production data file are automatically implemented in response to receipt of a confirmation to process a job (See page 5, paragraph 0052, also see page 5,

paragraphs 0059-0060).

As to claim 39, <u>VanDenAvond et al.</u> discloses wherein the production data file generated

can be directly input to the type of production machine for which the production data file was

generated (See page 5, paragraph 0054).

As to claim 40, <u>VanDenAvond et al.</u> discloses wherein the one or more orders can be

received from a location and the request to process the orders can be received from the same

location (See page 6, paragraph 0071, wherein "same location" reads on "local copy").

As to claim 41, <u>VanDenAvond et al.</u> discloses wherein a plurality of orders can be

received from different locations and processed together as one print job (See page 4, paragraph

0043, also see page 4, paragraph 0048).

As to claim 42, <u>VanDenAvond et al.</u> discloses wherein at least one of the stored

templates defines a layout of information to be printed on a label (See page 3, paragraph 0038,

also see page 5, paragraph 0054).

As to claim 47, <u>VanDenAvond et al.</u> discloses wherein the plate layout includes a layout

of information to be printed on each of the plurality of labels defined by the plate (See page 2,

paragraph 0026).

As to claim 49, <u>VanDenAvond et al.</u> discloses wherein the production file includes a data

stream that can be directly input to a printer for printing the labels of a job (See page 4,

paragraph 0043, also see page 5, paragraph 0054).

As to claim 50, <u>VanDenAvond et al.</u> discloses wherein the production file includes font

information (See page 4, paragraph 0045).

As to claim 52, <u>VanDenAvond et al.</u> discloses a system for producing labels at a plurality

of remote locations on a plurality of different types of production machines wherein the remote

locations are in communications with the system via the internet, comprising:

a database (See page 7, paragraph 0077); and

at least one server receiving orders for labels via the internet, the orders identifying

variable data to be printed on the labels and storing the orders in the database, at least one server

being responsive to a user's input to process a plurality of orders together to form a printing job

to be produced on an identified machine type and automatically generating a production data file

for the labels to be produced for the job, the at least one server thereafter storing the production

data file in the database, and sending a stored production data file to a remote location via the

internet (See page 6, paragraph 0063, also see page 6, paragraphs 0073-0074)

wherein said server operates in accordance with an order entry routine and said database

stores a plurality of data tables for a plurality of store groups accessed during the order entry

routine including for each store group a plurality of web page tables, each web page table

defining a plurality of web pages with different web pages being associated with different label

types available for ordering and each web page including a plurality of variable data entry fields

(See Figure 6, shows "Web page", also see page 3, paragraph 0034, and see page 7, paragraph

0075).

As to claim 53, <u>VanDenAvond et al.</u> discloses wherein said server operates in accordance

with a routine to allow new label types to be added to the system and available for ordering by

communication with the system via the internet, the routine being responsive to user inputs to

update the web page tables and automatically create a new web page to allow the new label type

to be ordered (See page 3, paragraph 0032, also see page 5, paragraph 0062).

As to claim 56, <u>VanDenAvond et al.</u> discloses wherein production data files are

generated for plate making machines (See page 2, paragraph 0026).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 22-23, and 55 are rejected under 35 U.S.C. 103(a) as being obvious over

<u>VanDenAvond et al.</u> (U.S. Pub. No. 2003/0004946 A1).

As to claims 22, and 55, <u>VanDenAvond et al.</u> discloses the claimed invention except for thermal printer i.e. specific type of printing device. <u>VanDenAvond et al.</u> does not explicitly teach thermal printer, however he teaches available printers, more than one type of printing device associated with label template and plurality of print devices on which the labels can be printed (See <u>VanDenAvond et al.</u> page 2, 0025, and see <u>VanDenAvond et al.</u> page 3, paragraph 0037).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to print to a thermal printer since it is known in the art that thermal printer is a type of printing device.

As to claim 23, <u>VanDenAvond et al.</u> discloses the claimed invention except for lithographic printer i.e. specific type of printing device. <u>VanDenAvond et al.</u> does not explicitly teach lithographic printer, however he teaches available printers, more than one type of printing device associated with label template and plurality of print devices on which the labels can be printed (See <u>VanDenAvond et al.</u> page 2, 0025, and see <u>VanDenAvond et al.</u> page 3, paragraph 0037).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to print to a lithographic printer since it is known in the art that thermal printer is a type of printing device.

Allowable Subject Matter

10.   Claims 25-28, 32, 43-46 are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims.

11.   Claim 48 would be allowable if rewritten to overcome the rejection(s) under 35

U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of

the base claim and any intervening claims.

Response to Arguments

12.   Applicant's arguments with respect to claims 14-50, 52-53, 55-56 have been considered

but are moot in view of the new ground(s) of rejection.

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

        Hajjar (U.S. Pub. No. 2001/0011279 A1) teaches interactive label selection system with

different printer types.

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
December 18, 2005